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In the Supreme Court of the United States

OCTOBER TERM, 1949.

No. 2

GRAVER TANK & MFG. CO., INC.,
THE LINCOLN ELECTRIC COMPANY,
GRAVER TANK & MFG. CORPORATION,
Petitioners,

v.

THE LINDE AIR PRODUCTS COMPANY,
Respondent.

ON WRIT OF CERTIORARI TO COURT OF APPEALS
FOR SEVENTH CIRCUIT.

PETITIONERS' PETITION FOR REHEARING.

JOHN F. OBERLIN,
Leader Building,
Cleveland 14, Ohio,

ASHLEY M. VAN DUZER,
THOMAS V. KOYKKA,
JAMES R. STEWART,
2800 Terminal Tower,
Cleveland 13, Ohio,

CHARLES L. BYRON,
First National Bank Building,
Chicago 3, Illinois,

Counsel for Petitioners.

June 9, 1950.

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PETITIONERS' PETITION FOR REHEARING.

Now come petitioners and petition for rehearing of the decision of May 29, 1950, holding claims 18, 20, 22, 23 of Jones patent 2,043,960 infringed.

The Court's opinion adjudging infringement demonstrates that there was, and could have been, no infringement, and that, but for serious misapprehension, the Court would have so held. Rehearing is therefore sought on the grounds:

1. The Court has adjudged infringement by attributing to the trial court findings it did not make.

This Court's opinion shows that it affirmed the judgment of infringement because:

1. The trial court held petitioners used for their welding flux a material, i.e., manganese silicate, which although not defined in the claims, was nevertheless an equivalent.

2. A finding of equivalence is a determination of fact.

3. There was in the record evidence from which the trier of the facts could find that manganese silicate (which petitioners used) was an equivalent of the material defined in the claims.

4. The trial court's fact finding, since there was evidence in the record to support it, must be accepted.

Were this the case—and assuming with the Court, as petitioners now necessarily do, that the doctrine of equivalents may be used to bring within the claims a material not defined therein—there could be no quarrel with this Court's decision.

But the difficulty is that *the finding this Court says it affirms, the trial court refused to make; and the evidence this Court points to as supporting the finding, the trial court said it would not consider.* The trial court left the matter in no doubt. It said:

> "*no determination need be made* whether it is a known chemical fact *outside*[1] the teachings of the patent that manganese is an equivalent of calcium or magnesium." (R. 920.)

Although this avowal of the basis of decision appears in the opinion, rather than in the findings, it is entitled to full honor under Rule 52(a) of the Federal Rules of Civil Procedure making findings conclusive unless clearly erroneous, on which this Court says it rests the judgment. Especially is this true here because the trial court specified that:

> "The Opinion filed herein *shall be considered a part* of these findings of fact and conclusions of law." (R. 928.)

[1] This emphasis is that of the trial court; all other emphasis throughout the brief is supplied.

The findings must therefore be read with the gloss the trial court put upon them. To do otherwise is not to respect the trial court's findings as required by Rule 52(a), but to remake them.

Moreover, when the trial court made its findings, it made clear that they were based upon a reading of the patent, and not upon the evidence. There is not the slightest suggestion in the trial court's opinion, in its findings, or in its conclusions of law that the issue of equivalence was decided as one of fact, or was based even in part upon the evidence. Note that although this Court supposed the finding of equivalency was drawn from the evidence, what the trial court found was:

> "Manganese silicate is one of the nine metallic silicates **which the specification discloses** that the inventors have used as principal constituents in welding compositions attaining more or less effectively the objectives of their invention." (Finding 13, R. 925.)
>
> "**The patent discloses** that manganese silicate * * * is a proper substitute * * *." (Finding 14, R. 925.)
>
> "A person skilled in the art can produce the accused Lincolnweld 660 flux by following the teaching **of the patent** * * *." (Finding 22, R. 926.)
>
> "**The patent in suit teaches** the substitution of manganese * * *." (Finding 24, R. 927.)

Furthermore, because the trial court did decide the issue as one of law, and not as one of fact, it declared the infringement, *not* in its fact findings, *but in its conclusions of law*. See conclusion of law 4. (R. 928.)

The trial court having taken special pains, first in its opinion, and then in its findings, to show the precise basis of decision, this Court should not now dispose of the case as though the trial court had done what it said it was not doing. Respect for the trial court's findings fairly requires that those findings be accepted as written.

To be sure, the trial court did find from the evidence that the two fluxes "are substantially identical in operation and in result" (Finding 20, R. 926), and that "in welding operation" (Finding 21, R. 926) they are equivalent, but that relates only to the result, and not to the means by which that result is brought about. Manifestly a flux cannot be declared an equivalent merely because it produces a good weld. Otherwise Linde will have a monopoly on *any* flux which will work. As heretofore has been remarked, acceptance of any such doctrine "would require, for instance in the field of alloys, that if one discovered a particular mixture of metals, which when alloyed had some particular desirable properties, he could patent not merely this particular mixture but the idea of alloying metals for this purpose, and thus exclude anyone else from contriving some other combination of metals which, when alloyed, had the same desirable properties." *Funk Brothers Seed Co. v. Kalo Inoculant Co.* (1948), 333 U. S. 127, concurring opinion, p. 134.

Here the findings show that the determination of equivalence—which this Court has affirmed in the mistaken belief that the issue was determined as one of fact, was rested by the trial court, not on the evidence, but upon a reading of the patent. It is clear, therefore, that but for this misapprehension as to the basis of decision this Court would have reversed the judgment of infringement. This must be so because this Court has already held (in its first opinion, 336 U. S. 271), and does not now withdraw therefrom, that the specification—the very one which the trial court relied upon—cannot so be read into the claims.

Now note what has happened.

This Court says it cannot "essay an independent evaluation of this evidence." (Slip opinion, p. 6.) Nor has the trial court evaluated this evidence. It says so. The trial court found it unnecessary to do so, as has been seen.

because it relied instead upon a rule of law—a rule this Court holds was erroneous. **The result is that a judgment is returned against these petitioners upon evidence no one has evaluated.** Thus, this Court has done the very thing it has reversed other courts for doing.[2]

Manifestly this Court did not intend to enter a judgment upon evidence no one has evaluated. It arrived at that result only because of its mistaken impression that the issue had been decided by the trial court as one of fact, and was therefore not subject to revision here.

Surely, if equivalency is to be decided as a question of fact—and a judgment entered on that basis—the Court should make sure it is so decided. And, if under the findings there remains any doubt whether the trial court did decide the issue—as it said it did—as one of law, or, as this Court supposed, found it as an issue of fact, the least this Court should do is to send the case back to the trial court to find out, and if need be, to hear evidence on the question *whether factually* the two fluxes can be regarded as equivalents.[3]

The evidence referred to by this Court (Slip opinion, pp. 5-6), does not even suggest equivalency. It was directed toward identity. The trial court rejected it upon the issue of identity in its finding that manganese is not

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[2] E.g., *Ohio Valley Water Company v. Ben Avon Borough* (1920), 253 U. S. 287, where the Court noted that power to pass on the evidence (p. 291), "must be plainly entrusted to some court in order that there may be due process of law." See also: *Cole v. Arkansas* (1948), 333 U. S. 196, 201-2; *Fountain v. Filson* (1949), 336 U. S. 681, 683; *Standard-Vacuum Oil Co. v. United States* (1950), 339 U. S. 157, 160-1.

[3] 28 U. S. C. §2106. Here, as in *Skelly Oil Company v. Phillips Petroleum Company*, No. 221, October Term, 1949, decided June 5, 1950, "the Court ought not now in darkness to pronounce on this question." See also: *Honeyman v. Hanan* (1937), 300 U. S. 14, 25; *Roth v. Delano* (1939), 338 U. S. 226, 231; *Kennedy v. Silas Mason Co.* (1948), 334 U. S. 249, 256-7.

an alkaline earth metal. The trial court might, in this Court's view, have considered it as evidence tending to show equivalence. That the trial court did not do. Having construed the claims in a manner which the trial court thought established equivalence—by reading the specifications as if they were claims—it never reached the point of measuring the evidence bearing upon it. But it is the trial court that ought to have the right to measure that evidence, determine its weight, and say whether it does establish equivalence, if that is the basis on which this case is to be decided.

As the matter now stands petitioners are branded as infringers without ever having had, in any court, an evaluation of the evidence on which it is said they are infringers. This is the very kind of thing this Court has always insisted constitutes the plainest kind of denial of due process. Willingly this Court would submit no man to that fate. It has happened here only because what the trial court decided *as an issue of law* this Court has mistakenly supposed was decided *as an issue of fact*.

Aside from this, the unintended consequences of this decision upon those concerned with patents—that is, the public—are even more momentous, as next will be pointed out.

2. Since, as this Court points out, the prior art disclosed the use of manganese silicate, it follows as a matter of law, under this very opinion, that the accused flux cannot infringe.

The Court has demonstrated that there is no infringement; but it has held there is.

This Court's opinion recognizes that:

> "The Miller patent, No. 1,754,566, which preceded the patent in suit, taught the use of manganese silicate in welding fluxes." (Slip opinion, p. 6.)

If so, then how, on any theory, can petitioners' use of manganese silicate be an infringement?

Petitioners' flux, the trial court found, is almost entirely—that is, 88.49%—manganese silicate.[4] Its use was disclosed by the prior art. This Court agrees that:

> "The disclosures of the prior art *made clear* that manganese silicate was a useful ingredient in welding compositions." (Slip opinion, p. 7.)

How can use of that which "the prior art made clear" be an infringement? How can it be an infringement, even assuming with the Court—what petitioners had believed was immaterial—that the record contains no evidence to show that Lincolnweld was developed as the result of independent research or experiments? Petitioners, equally with other members of the public, had the right to turn to, and freely use, what the prior art disclosed. By what course of logic or reasoning can a flux containing a major

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[4] On the other hand, the claims here in question are to a flux "containing a major proportion of alkaline earth metal silicate." The claims read (R. 960):

> "18. A composition for electric welding containing **a major proportion of alkaline earth metal silicate**, and being substantially free from uncombined iron oxide and from substances capable of evolving gases under welding conditions.
>
> 20. A composition for electric welding containing a fluoride and **a major proportion of alkaline earth metal silicate**, and being substantially free from uncombined iron oxide and from substances capable of evolving gases under welding conditions.
>
> 22. A finely-divided unbonded fusible electric welding composition containing a fluoride and **a major proportion of an alkaline earth metal silicate**.
>
> 23. A finely-divided unbonded fusible composition for use in electric welding employing a bare metal electrode as a source of weld metal, said composition being substantially free from substances capable of evolving a detrimental quantity of gas under welding conditions and containing calcium fluoride and **a major proportion of one or more alkaline earth metal silicates**."

proportion of manganese silicate be held to infringe when the prior Miller patent taught exactly[5] such use?

But if manganese silicate does infringe, then the decision, if permitted to stand, will have astonishing—and surely unintended—consequences. It will mean *that the disclosure of the prior art* that manganese silicate is an effective and useful constituent in a flux composition, authorizes and empowers a later patent claiming a specifically different silicate ingredient, nevertheless to include such manganese silicate as its equivalent.

Manifestly, this cannot be.

Since it is conceded, as it must be, that the use of manganese silicate was disclosed by the prior art, one of two results must follow:

1. the claims, if they are read to embrace what was disclosed by the prior art, are invalid, or
2. if the claims are valid, then they must be read to exclude manganese silicate which they do not mention.

Since, in the present posture of the case, the claims must be accepted as valid, it follows **under the very doctrine of equivalents here invoked,** that they are not infringed. **The decision that they are valid necessarily determines that manganese silicate is not an equivalent.** This must be so because if manganese silicate is an equivalent, as the Court now holds, then the claims are invalid because they embrace not only the new but the old as well. On this very ground this Court for more than 100 years has declared patents invalid.[6] The reason is, as this

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[5] The "primary object" of the prior Miller patent was to provide "a blanket of molten manganese silicate." (R. 969, col. 1, lines 43-5.) "*The invention* may be embodied in a rod having a coating of *manganese silicate*" (R. 969, col. 2, lines 53-4).

[6] See for example:

Stradman, *Patents*, p. 165;

Hotchkiss v. Greenwood (1850), 11 How. 248, 264-6;

(Continued on following page)

Court many times has had occasion to declare, that *whatever infringes if later must anticipate if earlier*.

But what this Court now has done is to hold in this one case that (1) manganese silicate *is not an equivalent* of alkaline earth metal silicate and the claims therefore are valid, but (2) manganese silicate *is an equivalent* of alkaline earth metal silicate and the claims therefore are infringed.

The Court cannot very well go in two directions in the same case. Manganese silicate cannot very well, in the same patent, at the same time, and in one case, both be and not be an equivalent.

The only escape from this dilemma is to restrict the claims to the compounds they actually define. Here, as in *Knapp v. Morss* (1893), 150 U. S. 221, and for the same reason (p. 228):

> "If * * * the patent could be sustained at all, it would have to be restricted and confined to the specific combination described in the * * * claim * * *."

In short, and in summary—on this point: the Constitution authorizes patents to secure to inventors the exclusive right "to *their* * * * Discoveries" (Article I, § 8), and not to discoveries of others—in this case Miller's. This fundamental condition is set forth in the statute. 35 U. S. C. § 31.

(Continued from preceding page)

Crouch v. Roemer (1880), 103 U. S. 797;
Florsheim v. Schilling (1890), 137 U. S. 64, 72, 76;
American Fruit Growers, Incorporated v. Brogdex Co. (1931), 283 U. S. 1, 14;
Cuno Engineering Corp. v. Automatic Devices Corp. (1941), 314 U. S. 84, 88-9;
Dow Chemical Co. v. Halliburton Oil Well Cementing Co. (1945), 324 U. S. 320, 326, 330;
General Electric Co. v. Jewel Incandescent Lamp Co. (1945), 326 U. S. 242, 247-8;
Mandel Brothers, Inc. v. Wallace (1948), 335 U. S. 291, 294-6;
Jungersen v. Osthoff & Barton Co. (1949), 335 U. S. 560, 564-7.

Specifically, under the statute a "composition of matter" is patentable only if it was:

> "not patented or described in any printed publication in this or any foreign country, before his [in this case Jones's] invention or discovery thereof . . ." (35 U. S. C. 31.)

Admittedly, the use of manganese-silicate as a welding composition is both patented and described in the prior Miller patent. Therefore, now that Miller has expired, the claims of Jones, under the doctrine of equivalents or otherwise, cannot so be read as to deprive the public of its right freely to use such previously patented composition.

Surely the decision calls for re-examination before it is cast adrift on the stream of the law. It will be understood by bench and bar as widening the scope of patents in revolutionary proportions. It is not believed this Court so intended. It would seem to be sensible to examine the decision now rather than explain it later. Before any possible explanation can be made, the decision, if permitted to stand as now written, will wreak havoc, and for years to come will plague industry, the public, and the courts.

Respectfully submitted,

JOHN F. OBERLIN,
ASHLEY M. VAN DUZER,
THOMAS V. KOYKKA,
JAMES R. STEWART,
CHARLES L. BYRON,
Counsel for Petitioners

CERTIFICATE.

We hereby certify that we believe the foregoing petition for rehearing is well grounded, that it should be granted, and that it is presented in good faith and not for delay.

JOHN F. OBERLIN,
ASHLEY M. VAN DUZER,
THOMAS V. KOYKKA,
JAMES R. STEWART,
CHARLES L. BYRON,
Counsel for Petitioners.

June 9, 1950.